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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,852	02/06/2004	Jurgen Adamek		7227

7590 06/01/2005  
Dr. Max Fogiel  
44 Maple Court  
Highland Park, NJ 08904

EXAMINER

WILLIAMS, THOMAS J

ART UNIT PAPER NUMBER

3683

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/773,852	Applicant(s) ADAMEK ET AL.	
	Examiner Thomas J. Williams	Art Unit 3683	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Acknowledgment is made in the receipt of the amendment filed March 28, 2005 and the change of address filed January 10, 2005.

#### ***Claim Objections***

2. Claims 9 and 15 are objected to because of the following informalities: each claim recites the secondary piston 9 having a bore 10 communicating with a beaker shaped hollow space 11. However, this does not appear to be very accurate. According to the figures the bore 10 is not provided in the piston 9 but is more likely provided in piston 2. The applicant should reconsider this language and correct the specification as well. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12, 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification and drawings fail to show or disclose "another secondary piston" in combination with first piston 2 and secondary piston 9. The language "another secondary piston" is interpreted as the intent to claim the existence of a third piston in combination with the two previously claimed pistons (i.e. the primary piston 2 and the secondary piston 9). The claims will be examined as having only a primary piston and the so-

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called secondary piston, which is in fact nothing more than a fixed wall segment having a reduced diameter passageway.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Re-claim 12 line 2, it is unclear as to which of the plurality of bores that "said bore" is referencing. Note that bore (claim 9) and a further bore (claim 11) have been previously claimed.

8. Re-claim 14 lines 1-2, it is unclear as to which bypass the recitation "said other bypass" is referencing. The claim language is completely non-descriptive and makes it difficult to determine what is being claimed. Using references like "said other bypass" renders the claim indefinite. It is suggested the applicant reference each element in an appropriate manner.

9. Re-claim 15 line 23, it is unclear as to which of the plurality of bores that "said bore" is referencing.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 5-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,974,707 Neumann et al.

Re-claim 5, Neumann et al. disclose in figure 3 a hydraulic dashpot for motor vehicles, comprising: a primary piston 104 and a cylinder 102 charged with fluid; a piston rod 107 with a lower end mounting the primary piston, the primary piston 104 divides the cylinder into two chambers 109 and 111, the piston rod travels axially into and out of the cylinder; the piston is provided with breaches (or passages 112 and 118), and shock absorbing valves 116 and 121 that vary the cross section of the breaches; a bypass system (passages 129a and 153) comprises two mutually dependently controlled bypasses between the two compartments, the bypass system can be closed and opened to various extents by controlling a sliding valve element 123a, the slide is provided with a flow control breach (124a and 152a), the slide travels back and forth across the two bypasses, which extend adjacent through it, a separate breach is provided for each bypass; a secondary piston (interpreted as the fixed wall segment having a restricted passage for fluid flow, illustrated as 154) is hydraulically received in bypass 153. It is noted that the "secondary piston" in the instant invention is nothing more than a valve or wall segment fixedly attached to housing 7, and is not truly a piston.

Re-claim 6, the two bypasses are opened and closed sequentially.

Re-claim 7, the two bypasses are opened and closed mutually discontinuously.

Re-claim 8, the two bypasses have different cross sections.

Re-claim 9, bore 156 communicates with the secondary piston and a beaker shaped hollow space (see figures), the hollow space receives the secondary piston and opens into an outlet (such as 129a) communicating with the chambers through a port (such as 124a).

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Alternatively, the secondary piston (or wall portion of Neumann et al.) is provided with a passageway, which can be interpreted as a bore. This bore is in communication with the hollow space and an outlet and port, as shown in the figures.

Re-claim 10, the slide is transverse to the outlet, a magnetic means 126a moves the slide back and forth.

Re-claim 11, a further bore (such as passage 153) extends above and parallel to the outlet 129a.

Re-claim 12, the bypass is formed by the bore the hollow space and the outlet.

Re-claim 13, fluid flows between the chambers under slow motion of the primary piston. Movement of the piston will force fluid to move from one chamber to the other chamber.

Re-claim 14, the device of Neumann et al. is provided with two bypasses, this meets the claim limitations.

Re-claim 15, it is the opinion of the examiner that all relevant limitations are anticipated by Neumann et al.

### ***Response to Arguments***

12. Applicant's arguments filed March 28, 2005 have been fully considered but they are not persuasive. It is the opinion of the examiner that the fixed wall segment in Neumann et al. can be interpreted as a "secondary piston" just like the fixed wall segment in the instant application is described as a secondary piston. It is opinion of the examiner that referring to element 9 as a secondary piston is not truly accurate. The arguments regarding the "another secondary piston" having damping valves are moot. As stated above the instant invention is not provided with three so-called pistons. The applicant needs to clearly claim each element as disclosed. The

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examiner agrees that significant differences exist between the instant invention and Neumann et al. However, the instant claims do not properly represent the instant invention.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Feist et al. teach a shock absorber with a bypass controlled by a slider.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128.

The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci, can be reached at 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

May 25, 2005

THOMAS WILLIAMS  
PATENT EXAMINER

Thomas Williams

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5-26-05